

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Hidehiko OGAWA

Group Art Unit: 2624

Appln. No. : 10/767,770

Examiner: Tommy D. LEE

Filed : January 30, 2004

For : IMAGE DATA COMMUNICATION DEVICE AND COMMUNICATION
METHOD

RESPONSE UNDER 37 C.F.R. § 1.116

Commissioner for Patents
U.S. Patent and Trademark Office
Customer Service Window, Mail Stop Amendment
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Sir:

In response to the Official Action dated April 6, 2006, in which a three-month shortened statutory period for response was set to expire on July 6, 2006, with the present Response being filed by the two-month due date of June 6, 2006, please amend the above-identified application as follows:

Amendments to the Claims are reflected in the listing of claims which begins on page 2 of this paper.

Remarks/Arguments begin on page 16 of this paper.

AMENDMENTS TO THE CLAIMS

This listing of claims will replace all prior versions, and listings, of claims in the application:

1. (Currently Amended) An image data communication apparatus connected to ~~an image data source~~ and to a network, and transmitting image data attached to an e-mail to a receiving apparatus via the network, the e-mail including a mail from command and a mail message, the image data communication apparatus comprising:

a scanner configured to scan image data;

a panel configured to input a mail ~~an e-mail~~ address of a user to the image data communication apparatus, the panel including a start button; and

a controller configured to control the scanner to scan the image data and to convert the scanned image data into a format for e-mail transmission in response to the start button being operated by the user of the image data communication apparatus,

the controller being further configured to set the mail e-mail address of the user, input by the panel, into the mail message of the e-mail to which the image data is attached, the mail e-mail address of the user being distinct from a mail ~~an e-mail~~ address of the image data communication apparatus, whereby the mail e-mail address of the user set into the mail message of the e-mail can be utilized as a destination of a reply to the e-mail, the reply being sent from the receiving apparatus, the reply being returned to the mail e-mail address of the user, the reply not being returned to the mail e-mail address of the image data communication apparatus.

2. (Canceled)

3. (Previously Presented) The image data communication apparatus according to claim 1, wherein the panel comprises a personal computer connected to the image data communication apparatus.

4. (Currently Amended) The image data communication apparatus according to claim 3, wherein the personal computer displays an HTML document for inputting the mail e-mail address of the user to the image data communication apparatus.

5. (Canceled).

6. (Currently Amended) An image data communication apparatus connected to ~~an image data source~~ and to a network, and transmitting image data attached to an e-mail to a receiving apparatus via the network, the e-mail including a mail from command and a mail message, the image data communication apparatus comprising:

a scanner configured to scan image data;

a panel configured to input a-mail ~~an e-mail~~ address of a user to the image data communication apparatus, the panel including a start button; and

a controller, in response to the start button being operated by the user of the image data communication apparatus, being configured to control the scanner to scan the image data and to convert the scanned image data into a format for e-mail transmission,

the controller being further configured to set the mail e-mail address of the user, input by the panel, into the mail message of the e-mail to which the image data is attached, the mail e-mail address of the user being distinct from a-mail ~~an e-mail~~ address of the image data communication apparatus, whereby a replay reply to the e-mail can be sent to the user without requiring input of the mail e-mail address of the

user at the receiving apparatus, the reply being sent from the receiving apparatus, the reply being returned to the mail e-mail address of the user, the reply not being returned to the mail e-mail address of the image data communication apparatus.

7. (Canceled)

8. (Previously Presented) The image data communication apparatus according to claim 6, wherein the panel comprises a personal computer connected to the image data communication apparatus.

9. (Currently Amended) The image data communication apparatus according to claim 8, wherein the personal computer displays an HTML document for inputting the mail e-mail address of the user to the image data communication apparatus.

10. (Canceled)

11. (Currently Amended) An image data communication apparatus connected to ~~an image data source and~~ to a network, and transmitting image data attached to an e-mail to a receiving apparatus via the network, the e-mail including a mail from command and a mail message, the image data communication apparatus comprising:

a scanner configured to scan image data;

a panel configured to input a-mail an e-mail address of a user to the image data communication apparatus, the panel including a start button; and

a controller, in response to the start button being operated by the user of the image data communication apparatus, being configured to control the scanner to scan the image data and to convert the scanned image data into a format for e-mail transmission,

the controller being further configured to set the mail e-mail address of the user, input by the panel section, into the mail message of the e-mail to which the image data is attached, the mail e-mail address of the user being distinct from a-mail an e-mail address of the image data communication apparatus, whereby a reply to the e-mail is returned to the mail e-mail address of the user, the reply not being returned to the mail e-mail address of the image data communication apparatus.

12. (Canceled)

13. (Previously Presented) The image data communication apparatus according to claim 11, wherein the panel comprises a personal computer connected to the image data communication apparatus.

14. (Currently Amended) The image data communication apparatus according to claim 13, wherein the personal computer displays an HTML document for inputting the mail e-mail address of the user to the image data communication apparatus.

15. (Canceled)

16. (Currently Amended) An image data communication apparatus connected to a network, the image data communication apparatus comprising:

a transmitter configured to transmit image data attached to an e-mail to a receiving apparatus via the network, the e-mail including a mail from command and a mail message;

a scanner configured to scan image data;

a panel configured to input a-mail an e-mail address of a user to the image data communication apparatus, the panel including a start button; and

a controller, in response to the start button being operated by the user of the image data communication apparatus, being configured to control the scanner to scan the image data and to convert the scanned image data into a format for e-mail transmission,

the controller being further configured to set the mail address of the user, input by the panel, into the mail message of the e-mail to which the image data is attached, the mail e-mail address of the user being distinct from a-mail an e-mail address of the image data communication apparatus, whereby the mail e-mail address of the user set into the mail message of the e-mail can be utilized as a destination of a reply to the e-mail, the reply being sent from the receiving apparatus, the reply being returned to the mail e-mail address of the user, the reply not being returned to the mail e-mail address of the image data communication apparatus.

17. (Canceled)

18. (Currently Amended) An image data communication apparatus connected to a network, the image data communication apparatus comprising:

a transmitter configured to transmit image data attached to an e-mail to a receiving apparatus via the network, the e-mail including a mail from command and a mail message;

a scanner configured to scan image data;

a panel configured to input a mail address of a user to the image data communication apparatus, the panel including a start button; and

a controller, in response to the start button being operated by the user of the image data communication apparatus, being configured to control the scanner to scan

the image data and to convert the scanned image data into a format for e-mail transmission,

the controller being further configured to set the mail e-mail address of the user, input by the panel, into the mail message of the e-mail to which the image data is attached, the mail e-mail address of the user being distinct from a-mail an e-mail address of the image data communication apparatus, whereby a replay reply to the e-mail can be sent to the user without requiring input of the mail e-mail address of the user at the receiving apparatus, the reply being sent from the receiving apparatus, the reply being returned to the mail e-mail address of the user, the reply not being returned to the mail e-mail address of the image data communication apparatus.

19. (Canceled)

20. (Currently Amended) An image data communication apparatus connected to a network, the image data communication apparatus comprising:

a transmitter configured to transmit image data attached to an e-mail to a receiving apparatus via the network, the e-mail including a mail from command and a mail message;

a scanner configured to scan image data;

a panel configured to input a-mail an e-mail address of a user to the image data communication apparatus, the panel including a start button; and

a controller, in response to the start button being operated by the user of the image data communication apparatus, being configured to control the scanner to scan the image data and to convert the scanned image data into a format for e-mail transmission.

the controller being further configured to set the mail e-mail address of the user, input by the panel section, into the mail message of the e-mail to which the image data is attached, the mail e-mail address of the user being distinct from a-mail an e-mail address of the image data communication apparatus, whereby a reply to the e-mail is returned to the mail e-mail address of the user, the reply not being returned to the mail e-mail address of the image data communication apparatus.

21. (Canceled)

22. (Currently Amended) A method for controlling an image data communication apparatus connected to an image data source and to a network, and transmitting image data attached to an e-mail to a receiving apparatus via the network, the e-mail including a mail from command and a mail message, the image data communication apparatus having a panel including a start button, the method comprising:

inputting a-mail an e-mail address of a user to the image data communication apparatus; and

scanning image data and converting the scanned image data into a format for e-mail transmission, in response to the start button being operated by the user of the image data communication apparatus; and

setting the input mail e-mail address of the user into the mail message of the e-mail to which the image data is attached, the mail e-mail address of the user being distinct from a-mail an e-mail address of the image data communication apparatus, whereby the mail e-mail address of the user set into the mail message of the e-mail can be utilized as a destination of a reply to the e-mail, the reply being sent from the receiving apparatus, the reply being returned to the mail e-mail address of the user, the

reply not being returned to the mail e-mail address of the image data communication apparatus.

23. (Canceled)

24. (Currently Amended) A method for controlling an image data communication apparatus connected to ~~an image data source~~ and to a network, and transmitting image data attached to an e-mail to a receiving apparatus via the network, the e-mail including a mail from command and a mail message, the image data communication apparatus having a panel including a start button, the method comprising:

inputting a ~~mail~~ an e-mail address of a user to the image data communication apparatus; and

scanning image data and converting the scanned image data into a format for e-mail transmission, in response to the start button being operated by the user of the image data communication apparatus; and

setting the input ~~mail~~ e-mail address of the user into the mail message of the e-mail to which the image data is attached, the ~~mail~~ e-mail address of the user being distinct from ~~a mail~~ an e-mail address of the image data communication apparatus, whereby a reply to the e-mail can be sent to the user without requiring input of the ~~mail~~ e-mail address of the user at the receiving apparatus, the reply being sent from the receiving apparatus, the reply being returned to the ~~mail~~ e-mail address of the user, the reply not being returned to the ~~mail~~ e-mail address of the image data communication apparatus.

25. (Canceled)

26. (Currently Amended) A method for controlling an image data communication apparatus connected to an image data source and to a network, and transmitting image data attached to an e-mail to a receiving apparatus via the network, the e-mail including a mail from command and a mail message, the image data communication apparatus having a panel including a start button, the method comprising:

inputting a mail an e-mail address of a user to the image data communication apparatus; and

scanning image data and converting the scanned image data into a format for e-mail transmission, in response to the start button being operated by the user of the image data communication apparatus; and

setting the input mail e-mail address of the user into the mail message of the e-mail to which the image data is attached, the mail e-mail address of the user being distinct from a-mail an e-mail address of the image data communication apparatus, whereby a reply to the e-mail is returned to the mail e-mail address of the user, the reply not being returned to the mail e-mail address of the image data communication apparatus.

27. (Canceled)

28. (Currently Amended) A method for controlling an image data communication apparatus connected to an image data source and to a network, and transmitting image data attached to an e-mail, the e-mail including a mail from command and a mail message, the image data communication apparatus having a panel including a start button, the method comprising:

inputting a-mail an e-mail address of a user to the image data communication apparatus;

scanning image data and converting the scanned image data into a format for e-mail transmission, in response to the start button being operated by the user of the image data communication apparatus;

setting the input mail e-mail address of the user into the mail message of the e-mail to which the image data is attached, the mail e-mail address of the user being distinct from a-mail an e-mail address of the image data communication apparatus, whereby the mail e-mail address of the user set into the mail message of the e-mail can be utilized as a destination of a reply to the e-mail, the reply being sent from the receiving apparatus, the reply being returned to the mail e-mail address of the user, the reply not being returned to the mail e-mail address of the image data communication apparatus; and

transmitting the image data attached to the e-mail to a receiving apparatus via the network.

29. (Canceled)

30. (Currently Amended) A method for controlling an image data communication apparatus connected to an image data source and to a network, and transmitting image data attached to an e-mail, the e-mail including a mail from command and a mail message, the image data communication apparatus having a panel including a start button, the method comprising:

inputting a-mail an e-mail address of a user to the image data communication apparatus;

scanning image data and converting the scanned image data into a format for e-mail transmission, in response to the start button being operated by the user of the image data communication apparatus;

setting the input mail e-mail address of the user into the mail message of the e-mail to which the image data is attached, the mail e-mail address of the user being distinct from a mail an e-mail address of the image data communication apparatus, whereby a reply to the e-mail can be sent to the user without requiring input of the mail e-mail address of the user, the reply being sent from the receiving apparatus, the reply being returned to the mail e-mail address of the user, the reply not being returned to the mail e-mail address of the image data communication apparatus; and

transmitting the image data attached to the e-mail to a receiving apparatus via the network.

31. (Canceled)

32. (Currently Amended) A method for controlling an image data communication apparatus connected to an image data source and to a network, and transmitting image data attached to an e-mail, the e-mail including a mail from command and a mail message, the image data communication apparatus having a panel including a start button, the method comprising:

inputting a mail an e-mail address of a user to the image data communication apparatus;

scanning image data and converting the scanned image data into a format for e-mail transmission, in response to the start button being operated by the user of the image data communication apparatus;

setting the input mail e-mail address of the user into the mail message of the e-mail to which the image data is attached, the mail e-mail address of the user being distinct from a-mail an e-mail address of the image data communication apparatus, whereby a reply to the e-mail is returned to the mail e-mail address of the user, the reply not being returned to the mail e-mail address of the image data communication apparatus; and

transmitting the image data attached to the e-mail to a receiving apparatus via the network.

33. (Canceled)

34. (Currently Amended) An image data communication apparatus connected to an image data source and to a network, and transmitting image data attached to an e-mail to a receiving apparatus via the network, the e-mail including a mail from command and a mail message, the image data communication apparatus comprising:

a scanner configured to scan image data;

a panel configured to input a-mail an e-mail address of a user to the image data communication apparatus, the user being distinct from the image data communication apparatus, the panel including a start button; and

a controller, in response to the start button being operated by the user of the image data communication apparatus, being configured to control the scanner to scan the image data and to convert the scanned image data into a format for e-mail transmission,

the controller being further configured to set the mail e-mail address of the user, input by the panel section, into the mail message of the e-mail to which the image data

is attached, the ~~mail~~ e-mail address of the user being distinct from ~~a mail~~ an e-mail address of the image data communication apparatus, whereby the ~~mail~~ e-mail address of the user set into the mail message of the e-mail can be utilized as a destination of a reply to the e-mail, the reply being sent from the receiving apparatus, the reply being returned to the ~~mail~~ e-mail address of the user, the reply not being returned to the ~~mail~~ e-mail address of the image data communication apparatus.

35. (Currently Amended) A method for controlling an image data communication apparatus connected to ~~an image data source~~ and to a network, and transmitting image data attached to an e-mail to a receiving apparatus via the network, the e-mail including a mail from command and a mail message, the image data communication apparatus having a panel including a start button, the method comprising:

inputting a ~~mail~~ e-mail address of a user to the image data communication apparatus, the user being distinct from the communication apparatus; and

scanning image data and converting the scanned image data into a format for e-mail transmission, in response to the start button being operated by the user of the image data communication apparatus; and

setting the input ~~mail~~ e-mail address of the user into the mail message of the e-mail to which the image data is attached, the ~~mail~~ e-mail address of the user being distinct from ~~a mail~~ an e-mail address of the image data communication apparatus, whereby the ~~mail~~ e-mail address of the user set into the mail message of the e-mail can be utilized as a destination of a reply to the e-mail, the reply being sent from the receiving apparatus, the reply being returned to the ~~mail~~ e-mail address of the user, the

P24500.A06

reply not being returned to the mail e-mail address of the image data communication apparatus.

REMARKS/ARGUMENTS

Upon entry of the above amendment, claims 1, 4, 6, 9, 11, 14, 16, 18, 20, 22, 24, 26, 28, 30, 32, 34, and 35 will have been amended and submitted for reconsideration by the Examiner. Claims 2, 5, 7, 10, 12, 15, 17, 19, 21, 23, 25, 27, 29, 31 and 33 will have been canceled without the prejudice or disclaimer.

In view of the above, Applicant respectfully requests reconsideration of the outstanding rejections of the claims pending in the present application. Such action is respectfully requested and is now believed to be appropriate and proper.

Initially, Applicant would like to express his appreciation to the Examiner for the detailed Official Action provided.

Applicant further notes with appreciation the Examiner's acknowledgment of Applicant's Information Disclosure Statement filed in the present application on January 6, 2006 by the return of the initialed and signed PTO-1449 Form, and for consideration of the documents cited in the Information Disclosure Statement.

Turning to the merits of the action, the Examiner has rejected claims 1-35 under 35 U.S.C. § 103(a) as being unpatentable over LEE et al. (U.S. Patent No. 5,742,769) in view of WEBER et al. (U.S. Patent No. 5,878,230). The Examiner has provisionally rejected claims 1-35 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-33 of co-pending Application No. 10/767,716.

As noted above, Applicant has amended claims 1, 4, 6, 9, 11, 14, 16, 18, 20, 22, 24, 26, 28, 30, 32, 34, and 35 for consideration by the Examiner. Applicant has canceled claims 2, 5, 7, 10, 12, 17, 19, 21, 23, 27, 29, 31 and 33 without the prejudice

or disclaimer. Applicant respectfully traverses the above rejection based on the pending claims and will discuss said rejection with respect to the pending claims in the present application as will be set forth hereinbelow. The amended claims merely clarify the subject matter recited in the rejected claims, but do not narrow the scope of the claims.

Applicant's claims 1, 3-4, 6, 8-9, 11, 13-16, 18, 20, and 34 generally relate to an image data communication apparatus (as defined, for example, in claim 1) connected to a network, and transmitting image data attached to an e-mail to a receiving apparatus via the network. The e-mail includes a mail from command and a mail message. The image data communication apparatus includes a scanner that scans image data. The image data communication apparatus includes a panel that inputs an e-mail address of a user to the image data communication apparatus. The panel includes a start button.

The image data communication apparatus includes a controller configured to control the scanner to scan the image data and to convert the scanned image data into a format for e-mail transmission, in response to the start button being operated by the user of the image data communication apparatus. Further, the controller sets the e-mail address of the user, input by the panel, into the mail message of the e-mail to which the image data is attached. The e-mail address of the user is distinct from an e-mail address of the image data communication apparatus. Then, the e-mail address of the user set into the mail message of the e-mail can be utilized as a destination of a reply to the e-mail, the reply being sent from the receiving apparatus. The reply is returned to the e-mail address of the user, but not to the e-mail address of the image data communication apparatus. Claims 22, 24, 26, 28, 30, 32, and 35 recite related methods.

In direct contrast, LEE et al. relates to a system in which individual users 10 can access the directory service 24 to obtain directory information about a large number of people and businesses (col. 2, lines 16-33). The users 10 can register basic directory information, i.e., names, addresses, and telephone numbers into the storage 30 of the directory service 24 (col. 2, lines 34-43, col. 4, lines 63-67, and col. 5, lines 1-16). The users 10 can search in the directory service 24 for the directory information of other users 10 (col. 2, lines 43-65, col. 6, lines 48-67 and col. 7, lines 1-12).

However, LEE et al. does not disclose an image data communication apparatus which sets the e-mail address of the user input by a panel into the mail message of the e-mail to which the image data is attached, the e-mail address of the user being distinct from an e-mail address of the image data communication apparatus, whereby the e-mail address of the user set into the mail message of the e-mail can be utilized as a destination for a reply to the e-mail, the reply being sent from the receiving apparatus, the reply being returned to the e-mail address of the user, and not being returned to the image data communication apparatus.

Rather, in LEE et al., the sender sets a sender's e-mail address into a "Reply-to" field; therefore, a reply to a sending e-mail is returned to the sender that has transmitted the sending e-mail (col. 7, lines 26-63). In other words, LEE et al. merely disclose a conventional reply mail.

On the other hand, and in stark contrast to LEE et al., the present invention recites an image data communication apparatus which sets the e-mail address of the user input by the panel into the mail message of the e-mail to which the image data is attached. The e-mail address of the user is distinct from an e-mail address of the image

data communication apparatus. Thus, in the present invention, the e-mail address of the user set into the mail message of the e-mail can be utilized as a destination for a reply to the e-mail, the reply being sent from the receiving apparatus. As a result, the reply is returned to the e-mail address of the user, but not to the image data communication apparatus.

Further, LEE et al. does not disclose an image data communication apparatus which has a scanner that scans image data and has a panel that includes a start button. LEE et al. also does not disclose an image data communication which, when the start button is operated by the user of the image data communication apparatus, controls the scanner to scan the image data and converts the scanned image data into a format for e-mail transmission. Rather, LEE et al. merely disclose individual users 10, servers 16 and 18, Internet providers 20 and 26, and the directory service 24. Thus, LEE et al. does not even disclose a device which has a scanner that scans image data and a panel that includes a start button and which, in response to the start button being operated by the user of the image data communication apparatus, controls the scanner to scan the image data and to convert the scanned image data into a format for e-mail transmission. In other words, LEE et al. merely relates to e-mail transmission by a personal computer, but does not disclose or even suggest e-mail transmission by an image data communication apparatus which has a scanner that scans image data and has a panel that includes a start button as recited in the combinations of the various independent claims.

As noted above, LEE et al. deals with nothing more than conventional e-mail reply procedures. In this regard, in addition to not including a scanner which is recited

in the pending claims and in addition to not controlling the scanner in a manner recited in Applicant's claims, Applicant further notes that LEE et al. does not set an e-mail address of a user, input by a panel into a mail message of an e-mail to which image data is attached. All LEE et al. provides for is a mechanism that copies a previously entered sender's e-mail address into a from field and a reply field. This is nothing more than conventional e-mail technology.

However, LEE et al. does not in any way provide at least a controller that is configured to set an e-mail address of a user that is input by a panel into a mail message of an e-mail to which image data is attached with the e-mail address of the user being distinct from an e-mail address of the image data communication apparatus. Nor does LEE et al. disclose that the e-mail address of the user that is set into the mail message of the e-mail can be used as a destination for reply that is sent from the receiving apparatus, the reply being returned to the e-mail address of the user but not returned to the image data communication apparatus.

In LEE et al., as can clearly be seen in column 7, lines 26-41, the sender (i.e., "From:") is the same as the reply. Accordingly, LEE et al. further fails to comply with the explicit recitation of Applicant's claims that the e-mail address of the user which is used as a destination for reply to the e-mail be distinct from the e-mail address of the image data communication apparatus which, as recited in the claims, is configured to transmit image data to a receiving apparatus via the network. For these additional reasons, it is respectfully submitted that LEE et al. is an inappropriate basis for the rejection of any of the claims in the pending application.

Thus, the pending claims are clearly distinct from LEE et al.

Therefore, it is respectfully submitted that the features recited in Applicant's pending claims are not disclosed in LEE et al. cited by the Examiner.

WEBER et al. discloses a system in which the sender may want to direct responses to the e-mail message to a variety of third-party recipients (column 3, lines 21-31) and in which, when third-party addressing (i.e., reply override) is indicated, the interexchange document profile IDP places the addresses specified by the original sender as the primary address field (column 5, lines 13-29).

However, WEBER et al. does not disclose an image data communication apparatus which has a scanner that scans image data and has a panel that includes a start button. WEBER et al. also does not disclose an image data communication apparatus which, in response to the start button being operated by the user of the image data communication apparatus, controls the scanner to scan the image data and converts the scanned image data into a format for e-mail transmission. Rather, WEBER et al. merely discloses individual computers 12 and 30, printer/output devices 16, storage devices 14, and the gateway server 28. Thus, WEBER et al. does not even disclose a device which has a scanner that scans image data and has a panel that includes a start button and which, in response to the start button being operated by the user of the image data communication apparatus, controls the scanner to scan the image data and converts the scanned image data into a format for e-mail transmission.

In other words, WEBER et al. merely relates to e-mail transmission by a personal computer and downstream routing of an e-mail message. However, WEBER et al. does not disclose or even suggest e-mail transmission by an image data communication

apparatus which has a scanner that scans image data and has a panel that includes a start button.

On the other hand, the present invention recites an image data communication apparatus which has a scanner that scans image data and has a panel that includes a start button and which, in response to the start button being operated by the user of the image data communication apparatus, controls the scanner to scan the image data and converts the scanned image data into a format for e-mail transmission.

WEBER et al. also does not relate to reply messages as that term is utilized in the present application. WEBER et al. requires the setting up of reply addresses as described with respect to step 56 of Fig. 5. However, WEBER et al. contains no teaching regarding setting of an e-mail address of a user, input by the panel, into the mail message of the e-mail to which image data is attached. Accordingly, for this additional reason, WEBER et al. is an inappropriate basis for the rejection of any of the pending claims herein.

Thus, the pending claims are clearly distinguished over WEBER et al.

Therefore, it is respectfully submitted that the features recited in Applicant's currently pending claims are not taught or disclosed in WEBER et al. cited by the Examiner.

Claims 1, 6, 11, 16, 18, 20, 22, 24, 26, 28, 30, 32, 34, and 35 are also submitted to be patentable over the Examiner's proposed combination. In particular, since neither LEE et al. nor WEBER et al. disclose the features recited in Applicant's claims 1, 6, 11, 16, 18, 20, 22, 24, 26, 28, 30, 32, 34, and 35, the pending claims are clearly distinguished over the combination of LEE et al. and WEBER et al.

Additionally, Applicant notes that the Examiner has not set forth a proper motivation for the modification of the teachings of LEE et al. by the teachings of WEBER et al. In particular, both LEE et al. and WEBER et al. merely relate to e-mail transmission by a personal computer. Thus, both LEE et al. and WEBER et al. do not disclose or even suggest e-mail transmission by an image data communication apparatus which has a scanner that scans image data and has a panel that includes a start button and which, in response to the start button being operated by the user of the image data communication apparatus, controls the scanner to scan the image data and converts the scanned image data into a format for e-mail transmission. Therefore, Applicant submits that even if one attempted to combine the teachings of LEE et al. and WEBER et al. in the manner suggested by the Examiner, one would fail to arrive at the instant invention, as defined by pending claims 1, 6, 11, 16, 18, 20, 22, 24, 26, 28, 30, 32, 34, and 35, since such a combination would fail to provide at least an image data communication apparatus which has a scanner that scans image data and has a panel that includes a start button and which, in response to the start button being operated by the user of the image data communication apparatus, controls the scanner to scan the image data and converts the scanned image data into a format for e-mail transmission.

Regarding the provisionally rejection of claims 1-35 under the judicially created doctrine of obviousness-type double patenting, Applicant's traverse the same. The claims of the cited co-pending application recite a memory, with the panel being configured to select the e-mail address of at least one user stored in the memory. These features are not recited in the claims of the present application. Thus the asserted rejection is inappropriate.

Nevertheless, and merely to advance the prosecution of the present application, Applicant is filing a Terminal Disclaimer in compliance with 37 C.F.R. § 1.321(c) to obviate the judicially created double patenting rejection. The Terminal Disclaimer includes a provision that any patent granted on the present application shall be enforceable only for and during such period that said patent is commonly owned with the application or patent which formed the basis for the rejection.

Submission of such Terminal Disclaimer should not be taken as an indication of Applicant's acquiescence with the propriety of the obviousness-type double patenting rejection. Rather, Applicant has submitted the Terminal Disclaimer solely in order to obtain early allowance of the claims of the present application.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejections and an indication of the allowability of all the claims pending in the present application, in due course.

SUMMARY AND CONCLUSION

Applicant has made a sincere effort to place the present application in condition for allowance and believes that he has now done so. Applicant has canceled some rejected claims without prejudice or disclaimer, and has amended other rejected claims for consideration by the Examiner. Applicant has filed a Terminal Disclaimer to obviate the provisionally rejection of the judicially created double patenting rejection. With respect to the rejected claims, Applicant has pointed out the features thereof and has contrasted the features of the rejected claims with the disclosure of the references. Accordingly, Applicant has provided a clear evidentiary basis supporting the patentability of all claims in the present application and respectfully requests an indication of the allowability of all the claims pending in the present application in due course.

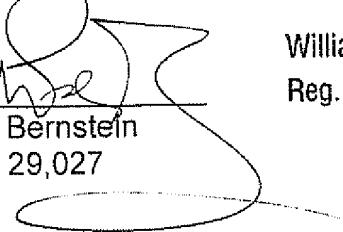
The amendments to the claims which have been made in this amendment, which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

Should an extension of time be necessary to maintain the pendency of this application, including any extensions of time required to place the application in condition for allowance by an Examiner's Amendment, the Commissioner is hereby authorized to charge any additional fee to Deposit Account No. 19-0089.

Should the Examiner have any questions or comments regarding this Response, or the present application, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,
Hidehiko OGAWA


Bruce H. Bernstein
Reg. No. 29,027


William Pieprz
Reg. No. 33,630

June 6, 2006
GREENBLUM & BERNSTEIN, P.L.C.
1950 Roland Clarke Place
Reston, VA 20191
(703) 716-1191